



UNITED STATES DEPARTMENT OF COMMERCE  
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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/153,287	11/17/93	HAUPTMANN	R 0652,0820002

18N2/1103  
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EXAMINER	
ART UNIT	PAPER NUMBER
1812	17

DATE MAILED:

11/03/94

Below is a communication from the EXAMINER in charge of this application

COMMISSIONER OF PATENTS AND TRADEMARKS

### ADVISORY ACTION

☒ THE PERIOD FOR RESPONSE:

- a) ☐ is extended to run \_\_\_\_\_ or continues to run \_\_\_\_\_ from the date of the final rejection
- b) ☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☒ Appellant's Brief is due in accordance with 37 CFR 1.192(a).

☒ Applicant's response to the final rejection, filed 10-18-94 (#15) has been considered with the following effect, but it is not deemed to place the application in condition for allowance:

1. ☐ The proposed amendments to the claim and /or specification will not be entered and the final rejection stands because:
- a. ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
- b. ☐ They raise new issues that would require further consideration and/or search. (See Note).
- c. ☐ They raise the issue of new matter. (See Note).
- d. ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- e. ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

2. ☐ Newly proposed or amended claims \_\_\_\_\_ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.

3. ☒ Upon the filing an appeal, the proposed amendment ☒ will be entered ☐ will not be entered and the status of the claims will be as follows:

Claims allowed: \_\_\_\_\_

Claims objected to: \_\_\_\_\_

Claims rejected: 2-7, 9-14, 17, 18, 22, 23

However;

☐ Applicant's response has overcome the following rejection(s): \_\_\_\_\_

4. ☒ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection because See Attached Sheet

5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.

☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.

☐ Other

Serial Number 08/153287

Art Unit 1812

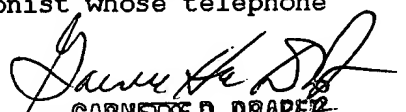
Attachment to Paper #17

Applicants discuss the teachings of Wallach 1 as to how one would obtain DNA encoding TNF-BP in view of the disclosed methods of Wallach 2. Applicants  
5 argue that the soluble TNF-BP of Wallach 1 is a cleavage product of the TNF receptor and not encoded by a discrete mRNA.

Wallach 2 is not cited in the rejection of the Claims. Applicants notation of cDNA libraries and probes, for example, used in Wallach 2 is not considered to be undue experimentation at the time the invention was made and  
10 this reference is not germane to the rejection. Wallach 1 clearly sets forth how one would acquire the DNA encoding the TNF-BP and this same method was used successfully by the Applicants. Even if the DNA encoding the membrane bound TNF-R would have been isolated, based on the N-terminal sequence of TNF-BP one would have reasonably determined that the TNF-BP is the extracellular  
15 domain of the TNF-R. See Olsson et al. Extracellular domains of receptors are commonly used as ligand binding proteins and such domains are routinely predicted in receptors (as transmembrane and cytoplasmic domains). As stated previously and above, the methods disclosed by Wallach 1 are considered to be routine and not obvious to try. The Wallach 2 reference does not supersede  
20 the teachings of Wallach 1 (with or without Olsson et al.) and is not relevant to the success of the Applicants in determining DNA encoding soluble TNF-BP using methods like those disclosed in Wallach 1.

Any inquiry concerning this communication or earlier communications from  
25 the examiner should be directed to Karen Cochrane Carlson, Ph.D., whose telephone number is (703) 308-0034. The Examiner can normally be reached Monday through Thursday from 7:00 A.M. to 4:30 P.M. The Examiner can also be reached on alternate Fridays.

Any inquiry of a general nature or relating to the status of this  
30 application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

  
GARNETTE D. DRAPER  
SUPERVISORY PRIMARY EXAMINER  
GROUP 1800